



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/663,183

09/16/2003

Jerry A. SpeasI

JMZ 1000-1US

1433

22470 7590 10/18/2010
HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY, CA 94019

EXAMINER

TOPGYAL, GELEK W

ART UNIT

PAPER NUMBER

2481

MAIL DATE

DELIVERY MODE

10/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/663,183 | Applicant(s) SPEASL ET AL. | |
| | Examiner GELEK TOPGYAL | Art Unit 2481 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-100,102,104 and 105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-100,102,104 and 105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/16/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 3-100, 102 and 104-105 have been considered but are moot in view of the new ground(s) of rejection.
2. The examiner elects to respond to a statement in page 23, wherein the applicants presents that Watanabe's clear purpose is to avoid any need for separate playback apparatus, teaches away from any combination in which a goal is to enable his memory card to be used with separate playback apparatus. In response, the examiner respectfully disagrees. The applicant's attention is directed to col. 6, lines 20-22 in Watanabe that specifically allows for the "memory cartridge to be connected to ... other recording apparatus or a **playback apparatus**". It seems quite clear that although Watanabe's one intention is allow for the memory cartridge to operate by itself for playback operations, it's also quite clear that it may be used by another "playback apparatus". Thus, at the least, Watanabe opens the door for any combinations whereby the memory cartridge can be modified to perform additional functions. The applicants are directed to the combination of Watanabe and Merritt below, wherein a clear motivation is provided for modifying the memory cartridge of Watanabe to perform additional functions.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2481

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 3-8, 10-17, 24-31, 38, 40, 42, 45-57, 63-67, 74-82, 85, 89, 93-100, 102, 104, 105** are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429).

5. **Regarding claims 1, 3-4, 45, 49, 74-77, 93-98, 100, 102 and 104-105,** Watanabe et al. teaches a portable memory device comprising a substrate supporting:

- a memory card having a memory (Figs. 5-7, Memory cartridge 20);

- a display on the card (Figs. 5-7, display 24);

- a communications interface on the card for establishing a user-severable communication link (col. 6, lines 50-61 teaches of connector 29) between the memory device and a plurality of different hosts at different times, wherein one of the hosts comprises a digital camera device (Fig. 6, Digital Camera 10), at least one of the hosts being physically larger than the memory device (Fig. 6);

- a mounting system for rigidly attaching the memory device to each of the host at different times (col. 6, lines 50-61 teaches of connector 29); and

- a controller on the card (Fig. 7, CPU 21) operable in response to user input to;

- store in the memory an image received from a first one of the hosts via the communication link while the portable device is in communication with the first host (col. 6, lines 50-61 and col. 5, lines 7-21 teaches the ability of the memory cartridge 20 of store images received from the digital camera 10);

render on the display an image represented in a file in the memory at least while the portable device is operating standalone and not in communication with the first host (col. 6, lines 10-15);

and communicate the image to the second host via the communication link according to the second image file format while the portable device is in communication with the second host (col. 6, lines 50-61 suggests that the memory cartridge 20 can be used with a digital electronic still video camera, hence a second digital still video camera is present).

However, the system of Watanabe fails to particularly teach the feature to determine a second image file format suitable for a second one of the hosts; and

transform an image in the memory from a first image file format to a second image file format, and

In an analogous art, Merritt et al. teaches the feature to determine a second image file format suitable for a second one of the hosts (col. 4, lines 32-39 teaches wherein an "image processing system 10 determines the preferred or optimum image format and/or protocol that are supported by the called party") and

transform an image in the memory from a first image file format to a second image file format (col. 5, lines 13-16 teaches "converts ... image file to the acceptable or preferred image file format of the called party");

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to determine a second format suitable for the second host and to transform the image according to the second format as taught

Art Unit: 2481

by Merritt et al. into the system of Watanabe because such incorporation allows for the benefits of enabling a multitude of dissimilar end-system devices, appliances, and platforms to interchange image information (Merritt, col. 1, lines 59-61).

As to claims 45 and to the limitation requiring a rigid attachment being such that the host is held rigidly relative to the display of the memory device, Figures 5-7 of Watanabe teaches wherein the memory cartridge's display 24 is held firmly in the recess 33 and vertical guide grooves 32 of the digital camera device.

As to claim 74 and 93, Merritt uses the preferred image format and/or protocols of the called party (second and receiving device) so that a second format can be achieved by converting a first format to a second format.

As to claims 97-98, 100, 102 and 105, the limitation of wherein the memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm and wherein the display fills said major surface except for a border no wider than 1/16 the size of said minor dimension (specifying a particular size/range of the bounding box does not make the specified limitation patentably distinct. See *In re Rose*, 105 USPQ 237 (CCPA 1955), wherein "differences in degree and/or size and [are] not patentable distinctions" and that "the size of the article under consideration is not ordinarily a matter of invention". It should be noted that the memory cartridge 20 of Watanabe consists of a display that covers a majority of the major surface and that the memory cartridge 20 consists of two parallel surfaces that is relatively thin);

As to claim 104, power means is met by the Solar battery 27 or dry cell 28 in Figure 7 in Watanabe.

As to claim 105, the limitations regarding a digital camera device is met by the device as illustrated in Figs. 2, 4 and col. 3, lines 42-50 and col. 4, lines 25-65 in Watanabe, wherein the digital camera consists of a lens unit through which the camera receives the image data which is later converted and stored on the memory 22. The memory 22 on the cartridge 20 meets the claimed digital camera device memory.

Claims 5-8 are rejected for the same reasons as discussed in claim 1 above, furthermore, the user's decision to use the memory cartridge 20 between multiple hosts at different times combined with the teachings of Merritt of the ability to transfer to and from the image file meets the claimed.

Regarding claims 10 and 11, Watanabe teaches an LCD display (col. 6, lines 65-66), however, fails to particularly teach that the group further consists of polymer with photoresist properties, a plasma display and an OLED display and a cholesteric display. It is noted that these display types are well known and old in the art, and therefore Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the different types of displays to increase compatibility with different types of display systems.

Claim 12 is rejected for the same reasons as discussed in claim 1 above, wherein Watanabe in Figs. 5-7 teaches the connector 29.

Regarding claims 13-14, Watanabe teaches the claimed wherein another one of the hosts could be a digital camera (a second digital camera 10).

Regarding claims 15-17, Watanabe's digital camera 10 meets consists of cartridge/slot (Col. 3, lines 42-67 teaches of a recess 33 and vertical guide grooves 32) for receiving memory cartridge 10. The memory cartridge 20 can be fastened to the connector on the digital camera 10 and then released/detached.

Regarding claims 24-26, Watanabe teaches the claimed in the memory cartridge 20 (The substrate layer of a memory device can be rigid or flexible).

Regarding claims 27-31, Watanabe teaches a processor (Fig. 7, CPU 21), a program memory (Fig. 7, Memory within CPU 21) separate from the first memory (Fig. 7, Image memory 22).

Regarding claims 38 and 40, Watanabe teaches the ability to store images from a digital camera 10 and the ability to review the images (see Col. 6, lines 26-49).

Claim 42 is rejected for the same reasons as discussed in claims 10 and 11 above, and furthermore, the system of Watanabe teaches a forward-feed switch 23a and reverse-feed switch 23b which meets the claimed button/receiver/switch for a remote control device.

Claims 46-48 are rejected for the same reasons as discussed in claims 15-17 above.

Claims 50-57 and 63-67 are rejected for the same reasons as discussed above in claims 5-9, 12, 14, 17, 24, 25, 27, 28 and 31, respectively.

Claims 78-82 and 85 are rejected for the same reasons as discussed above in claims 7, 8, 12, 13, 17 and 24, respectively.

Claim 89 is rejected for the same reasons as discussed in claim 38 above.

Claim 99 is rejected for the same reasons as discussed in claims 1 and claims 15-17 above.

6. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429) and further in view of Ando et al. (US 7,525,571).

7. **Regarding claim 9**, the proposed combination of Watanabe and Merritt et al. teaches the claimed as discussed in claim 1 above, however fails to particularly teach wherein the controller when operated to render on the display an image from the first host while the memory device is in communication with the first host, the image bypasses the memory.

In an analogous art, Ando et al. teaches in Fig. 18 and col. 18, lines 5-15 of the basic ability to display an image on a first device. The image displayed on the first device being only stored in the second device. The storage of the image on the first device only takes place when the transfer of the images is completed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to display an image from the first host on the memory device (first device and second device in Ando et al.) as taught by Ando et al. into the proposed combination of Watanabe and Merritt et al. so that a user is aware of the content of the images (by way of the previewing ability of Ando et al.) being transferred.

Art Unit: 2481

8. **Claims 18-23, 58-62 and 83-84** are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429) and further in view of Wakui (US 5,986,700).

Regarding claims 18-23, the proposed combination of Watanabe and Merritt teaches the claimed as discussed in claims 1, 45 and 74 above wherein upon a user's entry the digital camera 10 can record an image into a memory cartridge 10, however, fails to teach wherein one of the plurality of hosts has a slot for receiving a plurality of memory devices and the capability to record onto the plurality of memory at the same time.

In an analogous art, Wakui teaches in col. 5, lines 7-23 and col. 8, lines 15-24 of a digital camera that is capable of hosting multiple IC cards. Further, upon instruction of the user the image take by the digital camera is stored across the multiple memory cards simultaneously.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to use multiple memory cards and to store image/data on all the memory devices as taught by Wakui into the proposed combination of Watanabe and Merritt so that multiple copies of data/images can be generated.

Claims 58-62 are rejected for the same reasons as discussed above in claims 18-22, respectively.

Claims 83-84 are rejected for the same reasons as discussed above in claims 18 and 22, respectively.

9. **Claims 32, 34, 41, 68, 69, 72, 86 and 90** are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429) and further in view of Jones et al. (US 2002/0118949).

10. **Regarding claims 32, 34 and 41**, the proposed combination of Watanabe and Merritt et al. teaches the claimed as discussed in claim 1 above, and teaches the ability to store images transferred from a digital camera (see claims 1 and 14 above), however fails to teach wherein the sequential images are rendered on the display as a movie.

In an analogous art, Jones et al. teaches the claimed in Fig. 3, steps 301-315 teaches wherein still images can be compiled into MPEG1 stream and is stored locally on the computer first before writing to the VCD. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings on Jones et al. into the proposed combination of Watanabe and Merritt et al. to increase compatibility of systems that aren't able to reproduce a set of images.

Claims 68, 69 and 72 are rejected for the same reasons as discussed above in claims 32, 34 and 41, respectively.

Claims 86 and 90 are rejected for the same reasons as discussed above in claims 32 and 41, respectively.

11. **Claims 33, 35, 36, 70 and 87** are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429), and further in view of Jeong et al. (US 6,690,878).

Art Unit: 2481

12. **Regarding claims 33, 35 and 36**, the proposed combination of Watanabe and Merritt et al. teaches the claimed as discussed in claim 1 above, and teaches the ability to import videos from a digital device connected to the PC 410 (see col. 3, lines 46-51) and the PC 410 has the ability to review the video files, however, the proposed combination of Watanabe and Merritt et al. fails to particularly teach the feature to capture an image frame of the video file and store it as an image file in the first memory.

In an analogous art, Jeong et al. teaches in cols. 2-3 of the ability to capture a still image from a moving image stream and to input/generate file management function (image index information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to capture a still image and to generate file management functions into the proposed combination of Watanabe and Merritt et al. so that systems can use a captured still image for representing a larger movie file, especially in large databases/archives.

Claim 70 is rejected for the same reasons as discussed in claim 35 above.

Claim 87 is rejected for the same reasons as discussed in claim 35 above.

13. **Claims 37, 39, 43, 71 and 88** are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429) and further in view of Torres et al. (US 6,738,075).

14. **Regarding claims 37, 39 and 43**, the proposed combination of Watanabe and Merritt et al. teaches the claimed as discussed in claim 1 above, including the feature

Art Unit: 2481

for a digital camera (see above claim 14) which allows for still images to be taken, however fails to particularly teach wherein audio information (sound/associated sounds) can be associated with still images as they are rendered for display.

In an analogous art, Torres et al. (US 6,738,075) teaches in Figures 4-8, wherein audio messages (meeting the claimed "sound"/"associated sounds") can be recorded that is associated with a still image and to play the audio messages during playback of the said still images.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to store and reproduce an associated audio clip as taught in Torres et al. into the proposed combination of Watanabe and Merritt et al. in order to improve the ability to identify the still images taken with audible descriptions.

Claim 71 is rejected for the same reasons as discussed in claim 37 above.

Claim 88 is rejected for the same reasons as discussed in claim 37 above.

15. **Claim 44, 73 and 91** are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429) and further in view of Falcon (US 7,222,207).

Regarding claim 44, the proposed combination of Watanabe and Merritt et al. teaches the claimed as discussed in claim 1 above, however fails to particularly teach the feature to determine a geolocation of the portable memory device; and render on the display a map which includes a visible marking of the geolocation.

In an analogous art, Falcon teaches in col. 9, lines 24-35 the ability to determine the current location of a portable computing device and to display that location on a map.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to display a map with the current location into the proposed combination of Watanabe and Merritt so that users can utilize a map for navigational purposes.

Claim 73 is rejected for the same reasons as discussed in claim 44 above.

Claim 91 is rejected for the same reasons as discussed in claim 44 above.

16. **Claim 92** is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (US 4,887,161) in view of Merritt et al. (US 6,421,429) and further in view of Yeh (US 5,666,495).

Regarding claim 92, Watanabe et al. teaches a portable memory device comprising a substrate supporting:

a display (Figs. 5-7, display 24);

a communications interface on the card for establishing a user-severable communication link (col. 6, lines 50-61 teaches of connector 29) between the memory device and a plurality of different hosts at different times (Fig. 6, Digital Camera 10);

a controller on the card (Fig. 7, CPU 21) operable in response to user input to;

i) store in the memory an image received from a first one of the hosts via the communication link while the portable device is in communication with the first host (col.

Art Unit: 2481

6, lines 50-61 and col. 5, lines 7-21 teaches the ability of the memory cartridge 20 of store images received from the digital camera 10);

ii) render on the display an image represented in a file in the memory at least while the portable device is operating standalone and not in communication with the first host (col. 6, lines 10-15), and

However, the system of Watanabe fails to particularly teach the feature of a receptacle for receiving a further memory device removable from the portable memory device; and to transform an image in the memory from a first image file format to a second image file format. It should be noted that although Watanabe performs steps i) and ii), it does so based on a image file that is presently stored in image memory 22 (Fig. 4) of Watanabe, and not on a further memory device that is removable from the portable memory device.

In an analogous art, Merritt et al. teaches step iii) transforming an image in the memory from a first image file format to a second image file format (col. 5, lines 13-16 teaches "converts ... image file to the acceptable or preferred image file format of the called party");

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to transform the image according to the second format as taught by Merritt et al. into the system of Watanabe because such incorporation allows for the benefits of enabling a multitude of dissimilar end-system devices, appliances, and platforms to interchange image information (Merritt, col. 1, lines 59-61).

However, the proposed combination of Watanabe and Merritt et al. fails to teach a receptacle for receiving a further memory device removable from the portable memory device; and wherein steps i) and ii) are based on a image file that is presently stored in image memory 22 (Fig. 4) of Watanabe, and not on a further memory device that is removable from the portable memory device. Similarly, step iii) as taught by Merritt also fails to perform the step on an image that is stored in a further memory device.

In an analogous portable memory device art, Yeh teaches in col. 10, lines 28-51 and specifically lines 36-39 teaches “received data (which is received by the information storage and transfer device 400 in Fig. 4) can then be transferred to any medium connected to the device 400, including another IC another IC memory card in the IC memory card slot 403”. Yeh’s system allows for a receptacle in the form of the IC memory card slot 403, and further allows data received by the information storage and transfer device 400 to be stored on the IC memory card loaded in the receptacle.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to incorporate a receptacle into a memory device and to allow for the storing of received data into a memory device loaded into the said receptacle as taught by Yeh into the proposed combination of Watanabe and Merritt et al. because such incorporation allows for the benefit of “transfer ability” and “distribution” (see col. 10, lines 42-44 of Yeh) of data between a first memory device and a second memory device. The proposed combination allows for Watanabe’s steps i) and ii) to be performed on an image file that is stored in a further memory (IC memory

Art Unit: 2481

card of Yeh) and for the step iii) of Merritt to be performed on an image file that is stored in a further memory (IC memory card of Yeh).

As to the limitation of wherein the memory device fits within a bounding box having first and second parallel surfaces separated by no more than 10.5mm (specifying a particular size/range of the bounding box does not make the specified limitation patentably distinct. See *In re Rose*, 105 USPQ 237 (CCPA 1955), wherein “differences in degree and/or size and [are] not patentable distinctions” and that “the size of the article under consideration is not ordinarily a matter of invention”. It should be noted that the memory cartridge 20 of Watanabe consists of two parallel surfaces that is relatively thin).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2481

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2482

/Gelek Topgyal/
Examiner, Art Unit 2481